

Application No.: 09/889916

Docket No.: HHI-032USRCE

REMARKS

Claims 1-10 are pending in the application. Claims 1-10 are rejected.

Reconsideration and allowance of all pending claims are requested in view of the remarks below.

Claim Rejections – Under 35 U.S.C. § 103(a)

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over German Patent No. 1,508,800 or WO 91/12910 to Hugens and further in view of U.S. Patent No. 4,335,494 to Lemelson. Claims 1-10 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemelson and further in view of either German 1,508,800 or WO 91/12910. Applicant traverses these rejections.

Applicant notes that German Patent No. 1,508,800 and WO 91/12910 were previously cited by the Examiner. However, U.S. Patent No. 4,335,494 to Lemelson is a newly-cited reference. Lemelson is directed to a method of roll forming elongated solid shapes from solid flowable materials such as metal powders, metal shot, fragments or segments of metal in a weldable condition by continuously feeding same to die means which includes two or more power rotated rolls or rollers between which the flowable materials is fed and compressed to define its shape. In one example, the flowable material or particles are cold pressure welded. In another example, heat may be generated within or transferred to the material between the rolls by induction or resistance heating disposed within or adjacent to the rolls, thereby fusing or welding the material due to the heat and high pressure applied to the material by the rolls. See the Abstract of Lemelson. With reference to column 2, beginning at line 55, rollers, such as

Application No.: 09/889916

Docket No.: HHI-032USRCE

drums 67 and 71, rotate on shafts 68 and 72, respectively. Electrical energy for resistance welding is conducted to roller or drum 67 by brush 69. Drum 71 may be grounded by the use of brush 73. As noted beginning at column 5, line 67, the apparatus of Lemelson is alleged to have advantage over "conventional continuous casing apparatus in which an elongated shape is downwardly cast through an open mold or die."

With reference to the citation of the '800 patent in either rejection, Applicant notes that Applicant's earlier-submitted remarks have not been addressed by the Examiner. The previous Office Action attempted to assert that the '800 patent could be modified by simply adding a reinforcement material into the molten metal of the '800 patent if a composite article is designated. Applicant, with reference to a U.S. family member, Blum, previously replied and continues to assert that one of ordinary skill in the art would not look to Blum in order to produce light metal pellets having fibrous particles or similar additives, at least because of the electron gun 1 of Blum and because Blum makes no mention of a composite particle. Applicant notes that Blum uses an electron gun 1 to melt very high melting temperature material, such as uranium carbide introduced to the electron beam 3. See column 1, lines 62-68. As noted at column 1, lines 62-66, the electron beam is provided to melt the material introduced into the electron beam, which does not suggest the use of fibers, particles, or similar additives not formed of the metal being processed.

As an administrative matter, Applicant previously noted that because the text of the '800 patent is in German, Applicant is referencing an apparent family member, U.S. Patent No. 3,442,321 to Blum. However, as the Office Action continues to assert German Patent No. 1,508,800, Applicant requests that the Examiner withdraw the rejection over German Patent No.

Application No.: 09/889916

Docket No.: HHI-032USRCE

1,508,800 or provide a translation of the relevant text being cited for support of the rejection.
See MPEP § 706.02 (8th Edition, Feb 2003 revision)

In view of the above remarks, Applicant submits that the '800 patent is improper for modification for use with fibrous particles or similar additives. Therefore, Applicant submits that it is improper for combination with another reference to provide all of the limitations of claim 1 or 6. Applicant respectfully requests withdrawal of any rejection involving this reference or that the Examiner specifically comment regarding the translated text of the '800 patent being relied upon and Applicant's comments herein.

With reference to the combination of Lemelson and WO 91/12910 to Hugens, Applicant asserts that the references are not properly combinable. To properly combine references, an objective teaching leading to the combination must be shown. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). "The showing must be clear and particular.... Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Id.* Also, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See also MPEP § 2143.01.

As previously submitted and not yet replied to by the Examiner, Applicant again asserts that it would not be obvious to look to Hugen in order to produce light metal pellets having fibers, particles or similar additives, as Hugen makes no mention of such additives. The present Office Action asserts that it would have been obvious to add reinforcement material into the molten metal of the primary reference if a composite article is designated. However, Applicant

Application No.: 09/889916

Docket No.: HHI-032USRCE

asserts that no teaching in the references would make it obvious for one of ordinary skill in the art to modify Hugens to do so, or even look to Hugens to make a composite article. No support in the Office Action or the references has been provided for how the additive would be properly introduced to the molten material to provide for proper distribution in the input region 13 of Hugens. Applicant submits that it is not obvious to combine the upright configuration of Lemelson with the substantially lateral configuration of Hugens. Applicant also notes that Lemelson was published/issued in 1982 and Hugens was filed in 1990, but no mention of composite articles or such additives is found in Hugens, thereby suggesting that it would not have been obvious to use Hugens for composite articles as asserted in the OA.

Regarding the rejection of the claims under 35 U.S.C. § 103(a) as being unpatentable over Lemelson and further in view of WO 91/12910 to Hugens, the Office Action asserts that because Hugens shows grooves along the casting strand, dividing the strand along the grooves to obtain pellets, that it would be obvious to provide such grooves to Lemelson if pellets are to be obtained from the strand. Applicant notes that there is no support in the cited references for asserting that pellets are desired from Lemelson. Lemelson describes forming elongated solid shapes, and as shown in Figures 1 and 2, this does not appear to be any sort of pellet. Applicant submits that only by improperly using Applicant's own disclosure, might one be motivated to create a structure as claimed in Applicant's claims 1 and 6.

A statement that modifications of the prior art to meet the claimed invention would have been obvious because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*,

Application No.: 09/889916

Docket No.: HHI-032USRCE

28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Manufacturing Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Applicant submits that claims 2-5 and 10 are patentable at least by way of their dependency from claim 1, and claims 7-9 are patentable at least by way of their dependency from claim 6. In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. HHI-032USRCE from which the undersigned is authorized to draw.

Dated: June 14, 2004

Respectfully submitted,

LAHIVE & COCKFIELD, LLP

By 

David J. Ridders

Registration No.: 43,882

28 State Street
Boston, Massachusetts 02109
(617) 227-7400
(617) 742-4214 (Fax)
Attorney For Applicant